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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/467,100	12/10/99	COLEMAN R	PF-0049-2-DI

HM12/0503

INCYTE PHARMACEUTICALS INC
PATENT DEPARTMENT
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EXAMINER	
HUTSON, R	
ART UNIT	**PAPER NUMBER**
1652	5

DATE MAILED: 05/03/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/467,100	Coleman et al.
Examiner	**Group Art Unit**
Richard Hutson	1652

☒ Responsive to communication(s) filed on *Feb 8, 2000*

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *1* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) *2-7 and 12-28* is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims *2-7 and 12-28* are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

   I. Claims 2-4, 6, 7, 19-22, drawn to a nucleic acid encoding a human Jak2 kinase, compositions, cells, organisms comprising said nucleic acid as well as methods of expressing said nucleic acid, classified in class 435, subclass 194.

   II. Claim 5, drawn to a method of using an antisense molecule of the nucleic acid encoding human Jak2 kinase, classified in class 514, subclass 44.

   III. Claims 11-13, drawn to a human Jak2 kinase, classified in class 435, subclass 194.

   IV. Claim 14, drawn to a method of treating a subject with a human Jak2 kinase, classified in class 424, subclass 94.5.

   V. Claims 15-17, drawn to an antibody specific for human Jak2 kinase, classified in class 530, subclass 387.1.

   VI. Claim 18, drawn to a method of screening for a protein that binds to human Jak2 kinase, classified in class 435, subclass 7.8.

   VII. Claim 26, drawn to a method of screening for a compound that alters the expression of human Jak2 kinase, classified in class 435, subclass 6.

2. The inventions are distinct, each from the other because of the following reasons:

The DNA of Group I and the proteins of Groups III and V each comprise a chemically unrelated structure capable of separate manufacture, use and effect. The DNA comprises a nucleic acid sequence, the proteins of Groups III and V each comprise an unrelated amino acid sequence. The DNA has other utility besides encoding the proteins such as a hybridization probe, the proteins can be made by another method such as isolation from natural sources or chemical synthesis and the proteins have other utility besides acting as an antigen to induce the antibodies such as for the method of group IV.

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case the nucleic acid product of group I can be used to as a hybridization probe.

The protein of group III, and the antibody of Group V are unrelated to the method of Group II as they are neither used nor made by the method of Group II.

Inventions III and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P.

§ 806.05(h)). In the instant case the human Jak2 kinase product of group III can be used to synthesize the antibodies of group V.

The nucleic acid of group I, and the antibody of Group V are unrelated to the method of Group IV as they are neither used nor made by the method of Group IV.

Inventions III and VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case the human Jak2 kinase product of group III can be used to synthesize the antibodies of group V.

The nucleic acid of group I, and the antibody of Group V are unrelated to the method of Group VI as they are neither used nor made by the method of Group VI.

Inventions I and VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case the nucleic acid product of group I can be used to as a hybridization probe.

The protein of group III, and the antibody of Group V are unrelated to the method of Group VII as they are neither used nor made by the method of Group VII.

The methods of Groups II, IV, VI and VII are independent as they comprise different steps, utilize different products and produce different results.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper. "*For purposes of the initial requirement, a serious burden on the examiner may be prima facie shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search as defined in MPEP 808.02.*" (see MPEP 803). The serious burden of search has been established by the different classification of the inventions. A telephone call was made to Sandra Sather on 4/12/2000 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Hutson whose telephone number is (703) 308-0066. The examiner can normally be reached on M-F from 7:30 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapy Achutamurthy (Murthy), can be reached on (703) 308-3804. The fax number for Official Papers to Technology Center 1600 is (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Rebecca Prouty
PRIMARY
GROUP 1600

Richard Hutson Ph.D.
4/25/2000